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Application No.: 10/777,009

Inventor(s): Yun Xu, *et al.*

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1. Amended Appeal Brief in response to Notification of Non-Compliant Appeal Brief mailed on October 16, 2006 – 12 pages

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/777,009  
Inventor(s) : Yun Xu, *et al.*  
Filed : February 11, 2004  
Art Unit : 1615  
Examiner : David L. Vanik  
Docket No. : T-732 (Z-03416)  
Confirmation No. : 3413  
Customer No. : 27752  
Title : SHAVING COMPOSITIONS

**APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

This is an Amended Brief in response to the Notification of Non-Compliant Appeal Brief mailed on October 16, 2006.

This Brief is filed pursuant to the appeal from the decision communicated in the Office Action mailed on April 5, 2006 and Advisory Action mailed on July 11, 2006.

A timely Notice of Appeal was filed on August 4, 2006.

**REAL PARTY IN INTEREST**

The real party in interest is The Procter & Gamble Company of Cincinnati, Ohio. The application is assigned to The Gillette Company, which is owned by The Procter & Gamble Company.

**RELATED APPEALS AND INTERFERENCES**

There are no known related appeals, interferences, or judicial proceedings.

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### STATUS OF CLAIMS

Claims 1-13 and 32 are pending and stand rejected. Claims 14-31 have been canceled without prejudice.

Claims 1-13 and 32 are appealed.

A complete copy of the appealed claims is set forth in the Claims Appendix attached herein.

### STATUS OF AMENDMENTS

A proposed amendment after the Final Rejection (mailed on April 5, 2006) was filed on June 29, 2006. The proposed amendment to independent claim 1 consisted of incorporating the feature of original claim 7 (included in the Claims Appendix attached herein), and canceling claim 7 accordingly. Pursuant to the Advisory Action mailed on July 11, 2006, the Examiner declined to enter the proposed amendment as it was "not deemed to place the application in better form for appeal."

### SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is directed to methods of shaving, comprising applying to an area of skin a shaving composition comprising, *inter alia*, a combination of water-insoluble lubricating polymer particles and a water soluble polymer. The combination of these two materials is disclosed in the application as providing improved razor glide and lubricity, as noted, for example, by the following excerpts:

Preferred shaving compositions include a lubricating agent containing polymer particles that include PTFE, and one or more water soluble polymer(s). Preferred shaving compositions exhibit excellent lubricity and glide . . . (page 4, lines 6-8).

\* \* \*

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Suitable PTFE-containing polymer particles, when incorporated in a shaving preparation, will reduce the measured coefficient of friction between the razor cartridge and the user's skin, as compared to the coefficient of friction that would be obtained when using the same shaving preparation without the polymer particles (page 4, lines 12-15).

\* \* \*

Any water soluble polymer or polymer combination may be utilized which, when used in combination with the PTFE particles, reduces the coefficient of friction of the shaving composition relative to the coefficient of friction of the shaving composition without the water soluble polymer(s) (page 5, lines 12-15).

The subject matter of independent claim 1 is as follows: a method of shaving comprising applying to an area of skin a shaving composition and shaving said area of skin, wherein the shaving composition comprises an aqueous solution (*see, e.g.*, page 4, lines 2-3) including a cleansing or conditioning agent (*see, e.g.*, page 7, line 27 to page 8, line 10) for hair or skin, water-insoluble lubricating polymer particles comprising polytetrafluoroethylene (*see, e.g.*, page 4, lines 12-26), and a water soluble polymer (*see, e.g.*, page 5, line 1 to page 7, line 11), the shaving composition being substantially free of anionic polymers (*see, e.g.*, page 3, lines 18-26) and the lubricating polymer particles and water soluble polymer being present in a ratio of about 0.1:1 to about 10:1 (*see, e.g.*, page 7, lines 12-13).

The subject matter of independent claim 32 is as follows: a method of shaving comprising applying to an area of skin a shaving composition and shaving said area of skin, wherein the shaving composition comprises an aqueous solution (*see, e.g.*, page 4, lines 2-3) including a cleansing or conditioning agent (*see, e.g.*, page 7, line 27 to page 8, line 10) for hair or skin, from about 0.005% to 2% of water-insoluble lubricating polymer particles comprising polytetrafluoroethylene (*see, e.g.*, page 4, lines 12-30), and a water

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soluble polymer (*see, e.g.*, page 5, line 1 to page 7, line 11), the shaving composition being substantially free of anionic polymers (*see, e.g.*, page 7, lines 12-13).

#### GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-13 and 32 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. 5,587,156 (hereinafter "Wdowik") in view of PCT publication number WO 02/087519 A2 (hereinafter "Dodd").

#### ARGUMENTS

##### **A. The Rejection of Claims 1-13 and 32 Under 35 U.S.C. § 103**

***A Prima Facie Case of Obviousness Has Not Been Established Since There Is No Motivation To Combine The Disclosures Of Wdowik and Dodd To Impart Improved Lubricity and Glide***

Each of claims 1-13 and 32 recite a shaving composition comprising, *inter alia*, a specific combination of water-insoluble lubricating polymer particles comprising polytetrafluoroethylene and a water soluble polymer. This combination, as explicitly recognized and taught by appellants' specification, is to provide improved lubricity and glide.

The Examiner notes that Wdowik discloses shaving compositions that can employ about 0.1% to about 20% of an insoluble particulate additive, including polytetrafluoroethylene particles, but acknowledges that Wdowik fails to disclose inclusion of a water-soluble polymer. *See* the Final Rejection mailed on April 5, 2006, pages 2-3. Due to the shortcomings of Wdowik, the Examiner relies on the disclosure of polyethylene oxide and natural or synthetic gum water-soluble polymers by Dodd. *Id.* at

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page 4. In view of these independent disclosures, the Examiner then concludes that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to add polyethylene oxide and natural or synthetic gum water-soluble polymers to the invention advanced by [Wdowik] in view of the teachings of [Dodd]." *Id.*

Wdowik discloses the incorporation of particulate additives into shaving compositions to provide three specific benefits: 1) microscopic support to the razor blade; 2) to extract hair away from its follicle prior to the blade cutting the hair; and 3) removal of dirt, oils, stains, and dead skin cells, foreign materials, irregular skin surface, and dead cells. *See, e.g.,* column 4, lines 15-36. *Notably absent from the Wdowik list is the benefit of lubricity and glide.*

Dodd discloses shaving compositions containing highly lubricious water soluble polymers. Dodd does not however, disclose the use of water insoluble particles.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. *See* MPEP §2142. Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellants submit that there is no motivation or suggestion to combine the teachings of Wdowik and Dodd for the development of a shaving composition having improved lubricity and glide. One of ordinary skill in the art would not look to Wdowik to build upon the lubricous features taught by Dodd since Wdowik's specific list of beneficial effects flowing from the insoluble particulate additives is silent with respect to lubricity and glide. Moreover, Wdowik states, in the Background of the Invention Section, "the thought of including solid, insoluble particles in shaving compositions might appear to be offensive and counter-intuitive for a material which is applied to the face." *See*, column 2, lines 52-55. Thus, the skilled artisan could only perceive from Wdowik's disclosure as a whole that including insoluble particles in a shaving composition is generally counter-intuitive, but that one may employ the same specifically for 1) microscopic support to the razor blade; 2) to extract hair away from its follicle prior to the blade cutting the hair; and 3) removal of dirt, oils, stains, and dead skin cells, foreign materials, irregular skin surface, and dead cells. Wdowik does not

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however include a counter-intuitive exception for the benefit of lubricity and glide. And Dodd does not indicate any shortcomings in lubricity in shaving compositions disclosed therein; in fact, Dodd states that "certain high molecular weight water soluble polymers . . . are highly lubricious and, therefore, ideal for inclusion in shaving compositions." See page 2, lines 33-35. Accordingly, Appellants submit that there is no motivation or suggestion from Wdowik and Dodd to combine water soluble polymers and water insoluble particulate additives to create a shaving composition having improved lubricity and glide.

**B. The Rejection of Claims 1-13 Under 35 U.S.C. § 103**

**The Broad Disclosures Of Wdowik and Dodd Fail To Suggest The Recited Ratio Of Lubricating Polymer Particles to Water Soluble Polymer**

Each of claims 1-13 recite "the lubricating polymer particles and water soluble polymer being present in a ratio of about 0.1:1 to about 10:1." The Examiner states that "[b]ased on the 0.1% to about 20% by weight of insoluble polymers advanced in [Wdowik], it is the examiner's position that one of ordinary skill in the art at the time the invention was made would have the ability to modify the amount of water insoluble particles such that the ratio of water soluble polymer and water insoluble particles are within the range of the instant claims 1 and 4 . . . This is because the amount of water insoluble polymers can be varied from 0.1% to about 20% based on particular application so long as the particles are present in an amount capable of providing support for a razor blade." Appellants first respond by noting that, as the examiner states, the range of particulate incorporation is for blade support, and not for lubricity and glide. Appellants respond further by pointing out that Wdowik discloses a broader range of particulate incorporation than that cited by the examiner—less than 0.1% to even as high as 90% or greater (see column 3, lines 36-40)—and that this extremely broad range of incorporation provides no guidance whatsoever to the skilled artisan for combining with water soluble polymers in a particular ratio for providing improved lubricity and glide.

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**C. The Rejection of Claim 32 Under 35 U.S.C. § 103**

**Wdowik and Dodd Fail To Suggest A Shaving Composition That Is Substantially Free Of Anionic Polymers**

Independent claim 32 is directed to a method of shaving comprising applying to an area of skin a shaving composition and shaving said area of skin, wherein the shaving composition comprises an aqueous solution including a cleansing or conditioning agent for hair or skin, from about 0.005% to 2% of water-insoluble lubricating polymer particles comprising polytetrafluoroethylene, and a water soluble polymer, *the shaving composition being substantially free of anionic polymers*. Wdowik and Dodd fail to teach a shaving composition as recited in claim 32.

The Examiner states that “[b]ased on claims 1-8 [of Wdowik], it is the examiner’s position that the composition is substantially free of anionic polymers. Appellants respectfully submit that claims 1-8 of Wdowik are completely silent with respect to any negative limitation, including the particular negative limitation of being “substantially free of anionic polymers”, as is recited in claim 32. Furthermore, each of Wdowik and Dodd include a statement that various modifications can be made to their respective disclosures without departing from the scope of the invention. *See* Wdowik at column 7, lines 50-58 and Dodd at page 15, line 34 to page 16. Neither Wdowik nor Dodd state however that such modifications should avoid substantial employment of anionic polymers.



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**SUMMARY**

In view of all of the above, it is respectfully submitted that the Section 103 rejections of record be withdrawn.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY



Signature

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## CLAIMS APPENDIX

1. (Previously presented) A method of shaving comprising applying to an area of skin a shaving composition and shaving said area of skin, wherein the shaving composition comprises an aqueous solution including a cleansing or conditioning agent for hair or skin, water-insoluble lubricating polymer particles comprising polytetrafluoroethylene, and a water soluble polymer, the shaving composition being substantially free of anionic polymers and the lubricating polymer particles and water soluble polymer being present in a ratio of about 0.1:1 to about 10:1.
2. (Original) The method of claim 1 wherein the water soluble polymer comprises polyethylene oxide.
3. (Original) The method of claim 1 wherein the shaving composition is in the form of a shaving lotion, cream, foam or gel.
4. (Previously presented) The method of claim 1 wherein the lubricating polymer particles and water soluble polymer are present in a ratio of about 0.25:1 to 3:1.
5. (Original) The method of claim 1 wherein the shaving composition includes from about 0.005% to 2% of said lubricating polymer particles.
6. (Original) The method of claim 1 or 5 wherein the shaving composition includes from about 0.01 to 2.0% of said water soluble polymer.
7. (Original) The method of claim 1 wherein the polymer particles have an average particle size of from about 1  $\mu\text{m}$  to 100  $\mu\text{m}$ .
8. (Original) The method of claim 1 wherein the shaving composition further comprises from about 3 to 25% of a water dispersible or water soluble surface active agent.

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9. (Original) The method of claim 1 wherein the cleansing or conditioning agent is selected from the group consisting of beard wetting agents, skin conditioning agents, cleansing agents, lathering agents, emollients, humectants, skin freshening and soothing agents, silicones, vitamins, and water dispersible or soluble surface active agents.

10. (Original) The method of claim 1 wherein the water soluble polymer is selected from the group consisting of polyethers, vinyl polymers, vinyl copolymers and terpolymers, natural polymers, and mixtures thereof.

11. (Original) The method of claim 1 wherein the water soluble polymer comprises a blend of polyethylene oxide and a water soluble natural or synthetic gum.

12. (Original) The method of claim 10 or 11 wherein the shaving composition includes from about 0.01 to 2.0% of said water soluble polymer.

13. (Original) The method of claim 10 wherein said water soluble polymer has a molecular weight of at least one million.

14-31. (Canceled).

32. (Previously presented) A method of shaving comprising applying to an area of skin a shaving composition and shaving said area of skin, wherein the shaving composition comprises an aqueous solution including a cleansing or conditioning agent for hair or skin, from about 0.005% to 2% of water-insoluble lubricating polymer particles comprising polytetrafluoroethylene, and a water soluble polymer, the shaving composition being substantially free of anionic polymers.

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## EVIDENCE APPENDIX

None.

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### RELATED PROCEEDINGS APPENDIX

None.